

Application Serial No. 10/799,018  
Attorney Docket No. 2156-613A

Examiner: M. Cleveland  
Art Unit: 1762

### REMARKS

Claims 1-8, 10-12, and 28-32 are currently pending in the present application. Claim 1 has been amended, claims 9 and 13-27 have been canceled and new claims 28-32 have been added.

New claims 28-32 have been added to more clearly define the invention over the prior art of record. New claim 28 sets forth several preferred non-conductive substrates. Support for this claim can be found in the specification, for example at page 11, lines 27-32. New claims 29-32 describe additional features of the activating solution as described in the specification, for example at page 8, line 28 through page 9, line 4. No new matter is believed to have been added by virtue of these amendments.

### Election/Restriction

Applicant hereby confirms the election of Group I, claims 1-12, directed to the method, and reserves the right to subsequently file a divisional application directed to the nonelected claims. Applicant has cancelled, without prejudice, claims 13-27 herein in accordance with this election.

### Rejections Under 35 U.S.C. §103

Claims 1-9 and 11-12 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Doty et al. (U.S. Patent No. 3,647,699) and Gedrat (U.S. Patent No. 4,285,991) in view of each other.

The Examiner asserts it would be obvious to combine the teachings of the '699 patent and the '991 patent to achieve the claimed invention.

Applicant has amended claim 1 to affirmatively recite that the manganese oxide formed on the surface of the non-conductive substrate during the etching step substantially remains on the surface of the non-conductive substrate during the

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subsequent activating step. Applicant respectfully submits that none of the cited references, alone or in combination describe or suggest this feature of the invention.

The '699 patent discloses that after conditioning (etching) in various  $\text{KMnO}_4$ - $\text{H}_3\text{PO}_4$  solutions, the panels are sensitized in a solution containing  $\text{SnCl}_2$ ,  $\text{HCl}$ , and  $\text{H}_2\text{O}$  (column 2, lines 56-61) and that thereafter the panels are activating in a palladium activating solution. As described in Applicant's disclosure (page 8, lines 11-16), it has been found that the manganese oxide film formed on the surface enhances activation. In contrast the sensitizing solution described in the '699 patent, is the same as the stripping solution described in U.S. Patent No. 6,645,557 to Joshi (referenced on page 2, line 20, and page 5, line 17 of the disclosure), which removes permanganate residue from the surface of the non-conductive substrate.

The '991 patent does not cure the deficiencies of the '699 patent because the '991 patent does not describe or suggest a  $\text{KMnO}_4$ - $\text{H}_3\text{PO}_4$  etching solution and would therefore not need the sensitizing solution described in the '699 patent.

Thus, as is readily seen, the '699 patent and the '991 patent do not describe or suggest all of the elements of the claimed invention. Reconsideration and withdrawal of the rejection of claims 1-8 and 11-12 as being unpatentable over the '699 patent and the '991 patent is respectfully requested.

Claim 10 stands rejected under 35 U.S.C. §103(a) over the '699 patent and the '991 patent in view of each other and further in view of Goffredo et al. (U.S. Patent No. 4,756,685).

Because claims 1-8 and 11-12 are believed to be allowable over the prior art of record for the reasons stated above, it is believed that claim 10, which depends from claim 1, would also be allowable over the prior art of record. Reconsideration and

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withdrawal of the rejection of claim 10 as being unpatentable over the '699 patent and the '991 patent and further in view of the '685 patent is respectfully requested.

### CONCLUSION

Applicant believes that the foregoing is a full and complete response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejection of the claims is requested. Applicants believe that claims 1-8, 11-12, and 28-32 are now in condition for allowance and an indication of allowability and an early Notice of Allowance of all of the claims is respectfully requested.

If the Examiner perceives of any reason why such allowance should not be granted he is requested to contact the undersigned at (203) 575-2648 for a telephonic interview prior to issuance of the next office action.

Respectfully submitted,

By:   
Jennifer A. Calcagni/Reg. No. 50,207  
Carmody & Torrance LLP  
50 Leavenworth Street  
P.O. Box 1110  
Waterbury, CT 06721-1110  
Telephone: (203) 575-2648  
Facsimile: (203) 575-2600

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